

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re REISSUE PATENT APPLICATION of

Atty. Ref: 36-1008

ATTWATER et al.

Serial No.: 09/930,395 (Reissue of Patent No. 5,940,793)

Filed: August 16, 2001

For: **VOICE-OPERATED SERVICES**

Hon. Commissioner of Patents
and Trademarks
Washington, DC 20231

Sir:

FACTUAL DECLARATION OF BARRY LLOYD

Barry Lloyd hereby declares and states as follows:

I am an in-house patent attorney working in the Intellectual Property Department of British Telecommunications public limited company (Assignee of record in the subject application, hereinafter the "Assignee"), having offices at Holborn Centre, 8th Floor, 120 Holborn, London, England EC1N 2TE.

I wrote European Patent Application No. 94307843 (hereinafter the "EP '843 application") filed October 25, 1994 and co-wrote with Juliet Hibbert, who was at that time another in-house patent attorney working in the Intellectual Property Department of Assignee, International Application No. PCT/GB95/02524 (hereinafter the "PCT '524 application") filed October 25, 1995. The PCT '524 application claims priority benefits from the EP '843 application and includes essentially all of the disclosure of the

EP '843 application plus additional disclosure. During prosecution of the PCT '524 application, an international search report dated May 31, 1996 was issued by the International Search Authority. On information and belief, Juliet Hibbert reviewed the international search report and became aware of the references cited therein.

National phase applications from the PCT '524 application were filed including European Patent Application No. 95934749.3 (hereinafter the "EP '749 application") filed February 26, 1997, U.S. Application No. 08/817,673 (hereinafter the "U.S. '673 application") filed April 21, 1997, and New Zealand Application No. 294296 (hereinafter the "NZ '296 application"), filed February 26, 1997. I was not actively involved with the filings of the EP '749, U.S. '673 or NZ '296 applications.

In or around April, 2001 I took over responsibility of working on prosecution of the EP '749 application pending in the European Patent Office on behalf of Assignee. I took over this responsibility from Alison D. Simons, who was once a trainee within the Intellectual Property Department of Assignee and later became an in-house patent attorney working in the same department, because Mrs. Simons ended her employment with Assignee in or around April, 2001. I was not, however, actively involved with the filing or any part of the prosecution of the U.S. '673 application which issued as U.S. Patent No. 5,940,793 on August 17, 1999 (i.e., issued before I took over responsibility of working on the prosecution of the EP '749 application). I also was not actively involved with the filing or any part of the prosecution of the NZ '296 application which issued as New Zealand Patent No. 294296 on August 11, 1999 (i.e., also issued before I took over

responsibility of working on the prosecution of the EP '749 application) or any New Zealand divisional application filed from the NZ '296 application.

After Assignee received a communication dated March 20, 2001 in the EP '749 application under Rule 51(4) of the European Patent Convention (similar to a Notice of Allowance in U.S. practice), I reviewed Assignee's file containing documentation relating to the EP '749 application. During my review of the file, I became aware of the existence of a supplemental search report dated October 22, 1998 from the European Patent Office for the EP '749. The supplemental search report cites all of the documents cited on the international search report in the PCT '524 application and also cites additional references (hereinafter, the "newly cited references"). I also became aware of the existence of the newly cited references.

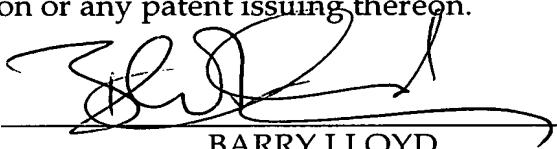
After reviewing the supplemental search report in detail, I realized that the newly cited references may be pertinent to claims that were canceled during the prosecution of the EP '749 application and which might form the subject of a European divisional application. I then obtained and reviewed the file containing documentation relating to the U.S. '673 application. I determined that the supplemental search report and the newly cited references were not provided to Assignee's retained outside U.S. counsel (i.e., the attorneys of record) and hence not filed in the U.S. Patent Office during the prosecution of the U.S. '673 application. The references cited in the international search report that were re-cited in the supplemental search report were cited in the U.S. '673 application.

In early August, 2001, I discussed the existence of the supplemental search report and the newly cited references with Alison Simons who was then and is currently a British patent attorney working in private practice. I also discussed the existence of the supplemental search report and the newly cited references with Bob Semos, an inhouse patent attorney currently working in the Intellectual Property department of Assignee. To the best of my information and belief, Mr. Semos served as Mrs. Simons' supervisor during her employment as a trainee in the Intellectual Property Department of Assignee including the time when Mrs. Simons worked with outside U.S. counsel on the prosecution of the U.S. '673 application. Mr. Semos informed me that he had no recollection of the prosecution of the U.S. '673 application. After discussing the matter separately with Mrs. Simons and Mr. Semos, I concluded with each that the failure to disclose the newly cited references to the U.S. Patent Office during prosecution of the U.S. '673 application was an inadvertent error.

After reviewing the file containing documentation relating to the EP '749 application, I ordered and obtained the file containing documentation relating to the NZ '296 application. Upon reviewing the contents of this file, I became aware of the existence of document WO 93/05605 (hereinafter "WO '605") which was cited in an official action dated August 7, 1997 from the New Zealand Patent Office. I had not previously been involved with the filing or prosecution of the NZ '296 application and was not previously aware of the existence of the WO '605. I then discussed the existence of WO '605 with Alison Simons and Bob Semos in separate conversations. I

concluded with each that the failure to disclose WO '605 to the U.S. Patent Office during the prosecution of the U.S. '673 application was an inadvertent error.

I declare further that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.


BARRY LLOYD

Date: 6 February 2002